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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,224	12/11/2000	Uwe Hansmann	DE919990103.US1	5431

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James E. Murray
69 South Gate Drive
Poughkeepsie, NY 12601

EXAMINER

DUONG, THOMAS

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,224

Applicant(s)

HANSMANN ET AL.

Examiner

Thomas Duong

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-7, 9-15, 17-25 and 27-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7, 9-15, 17-25 and 27-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on June 25, 2004. The amendment filed on June 25, 2004 has been entered and made of record. *Claims 1-2, 4-7, 9-15, 17-25 and 27-32* are presented for further consideration and examination.

Response to Argument

2. The Applicants' arguments and amendments filed on June 25, 2004 have been fully considered, but they are not persuasive.
3. With regard to claims 1, 14 and 24, the Applicants point out that:
 - *All the independent claims in the application are distinguishable from the Nguyen patent in that they call for an option selection display screen for user preselection of options and for displaying the initial information in a screen separate from the option display screen. Independent claim 14 further distinguishes in that it calls for functions to be performed in a server intermediate the network and the client machine: in the Nguyen patent there is no server intermediate the network and the client machine performing such function (see Figure 1).*

However, the Examiner finds that the Applicants' arguments are not persuasive and maintains that the Nguyen reference does disclose,
Nguyen (US006584498B2) teaches,

- *providing an option selection display screen for user preselection of options establishing priority criteria to be used in downloading of information to the client*

machine in anticipation of its presentation to the user; (Nguyen, Nguyen, col.7, lines 9-23, lines 33-53; Nguyen discloses that *"the operator may explicitly selects a set of preloading preferences and priorities"* (lines 13-14) and the fact that the client *"stores the preloading preferences and their relative priorities"* (lines 17-18) shows that the Nguyen invention allows the operator to select the preloading preferences from the available choices and further specify their loading priorities. Also, the preference selection step takes place before the operator selects an information page; therefore it can be interpreted that the selection of the preloading preferences is presented separately from the selected information page. Furthermore, it is well known in the art to present the operator with a separate window for selecting preferences or making configuration changes)

In summary, the Examiner maintains that Nguyen does disclose a step that present to the operator a separate window for making the preloading preferences and their relative priorities. Therefore, the Applicants still failed to clearly disclose the novelty of the invention and identify specific limitation, which would define patentable distinction over prior art.

4. With regard to claim 14, the Applicants point out that:

- *Independent claim 14 further distinguishes in that it calls for functions to be performed in a server intermediate the network and the client machine: in the Nguyen patent there is no server intermediate the network and the client machine performing such function (see Figure 1).*

In response to applicant's arguments, the recitation that *"calls for functions to be performed in a server intermediate the network and the client machine"* has not been given patentable weight because the recitation occurs in the preamble. A preamble

is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, the Applicants still failed to clearly disclose the novelty of the invention and identify specific limitation, which would define patentable distinction over prior art.

5. With regard to claims 2, 4-7, 9-13, 15, 17-23, 25 and 27-32, they are rejected at least by virtual of their dependency on the independent claims and by other reasons set forth in the previous office action. Accordingly, rejections for *claims 2, 4-7, 9-13, 15, 17-23, 25 and 27-32* are presented as below:

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claims 1-2, 4-7, 9-15, 17-25 and 27-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen (US006584498B2).
8. With regard to claims 1-2, 11-12, 14-15 and 24-25, Nguyen reference discloses,
- a) *providing an option selection display screen for user preselection of options establishing priority criteria to be used in downloading of information to the client machine in anticipation of its presentation to the user;* (Nguyen, Nguyen, col.7, lines 9-23, lines 33-53; Nguyen discloses that “*the operator may explicitly selects a set of preloading preferences and priorities*” (lines 13-14) and the fact that the

client *"stores the preloading preferences and their relative priorities"* (lines 17-18) shows that the Nguyen invention allows the operator to select the preloading preferences from the available choices and further specify their loading priorities.

Also, the preference selection step takes place before the operator selects an information page; therefore it can be interpreted that the selection of the preloading preferences is presented separately from the selected information page. Furthermore, it is well known in the art to present the operator with a separate window for selecting preferences or making configuration changes)

- *b) downloading of initial information from the network to the client machine;* (Nguyen, col.1, line 50 – col.2, line 9; col.3, line 44 – col.4, line 16; fig.1)
- *c) displaying in a screen separate from the option selection screen of the initial information on the client's machine by a browser;* (Nguyen, col.1, line 50 – col.2, line 9; col.3, line 44 – col.4, line 16; fig.1)
- *d) automatically checking of the initial information for the presence of links to other sets of information at a point no later than the display of the information in step b);* (Nguyen, col.1, line 50 – col.2, line 9; col.4, lines 26-40; fig.1)
- *e) automatically assigning of priorities to the links identified based on the options preselected by the user;* (Nguyen, col.4, lines 26-40; col.6, lines 49-59; col.7, lines 13-23; fig.1)
- *f) automatically downloading to the client's machine during display of the initial information of the sets of information assigned to the links in accordance with the priorities of the sets of information.* (Nguyen, col.1, line 50 – col.2, line 9; col.5, lines 58-63; col.6, lines 49-59; fig.1)

- *g) selecting and displaying on the client's machine a set of information from step f) (Nguyen, col.1, line 50 – col.2, line 9; col.5, lines 58-63; col.6, lines 36-46; fig.1)*
- *h) repeating steps d) to f) of the method for this set of information. (Nguyen, col.1, line 50 – col.2, line 9; col.5, lines 58-63; col.6, lines 36-46; fig.1)*

9. With regard to claims 4-6, 17-19 and 27-28, Nguyen reference discloses the invention substantially as claimed,

See *claims 1, 14 and 24* rejection as detailed above.

Furthermore, Nguyen reference discloses,

- *wherein the assigning of a priority includes expanding the links to include priority information provided by the author of the set of information concerned. (Nguyen, col.1, line 50 – col.2, line 9; col.6, lines 49-59; col.7, lines 13-23; fig.1)*
- *including the step the option selection display screen providing the option of assigning priority to the links in a purely sequential order. (Nguyen, col.6, lines 49-59; col.7, lines 13-23; col.8, lines 1-19; fig.1)*

10. With regard to claims 7, 20 and 29, Nguyen reference discloses the invention substantially as claimed,

See *claims 1, 14 and 24* rejection as detailed above.

Furthermore, Nguyen reference discloses,

- *including the steps of performing the assignment of priorities to the links by analysing user behaviour by means of a data mining program, (Nguyen, col.6, lines 49-59; col.7, line 54 – col.8, line 9; fig.1)*

- *storing all the sets of information downloaded from the network, or parts thereof, on the client's machine, (Nguyen, col.1, line 50 – col.2, line 9; col.5, lines 58-63; col.6, lines 49-59; fig.1)*
- *using a data mining program for accessing this information and analysing it statistically, and creating a sequence of priorities for the links by using an add-on program or browser extension. (Nguyen, col.6, lines 49-59; col.7, line 54 – col.8, line 9; fig.1)*

11. With regard to claims 9-10, 13, 21-23 and 30-32, Nguyen reference discloses the invention substantially as claimed,

See *claims 1, 14 and 24* rejection as detailed above.

Furthermore, Nguyen reference discloses,

- *purely sequential downloading of links on a centre/top-down/bottom-up basis; (Nguyen, col.6, lines 49-59; col.7, lines 13-23; col.8, lines 1-19; fig.1)*
- *downloading of sets of information whose links include priorities down to a lowest priority which can be decided by the user; (Nguyen, col.1, line 50 – col.2, line 9; col.5, lines 58-63; col.6, lines 49-59; fig.1)*
- *assigning priorities as a result of analysis of user behaviour, set by means of the following options:*
 - *specification of a lowest probability to be specified by user; calculation of changeover probability; calculation of site-content probability. (Nguyen, col.6, lines 49-59; col.7, line 54 – col.8, line 9; fig.1)*
- *including the step of selecting between allowing the user profile to automatically assigns a priority to the options selected or permitting the assignment of the*

priority to be performed by the user. (Nguyen, col.1, line 50 – col.2, line 9; col.6, lines 49-59; col.7, lines 9-23; fig.1)

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 571/272-3923. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9306 for After Final communications. Any inquiry of a general nature or relating

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to the status of this application or proceeding should be directed to the receptionist
whose telephone number is 571/272-2100.

Thomas Duong (AU2143)

October 29, 2004

Will C. Vaughn
Primary Examiner
Art Unit 2143
William C. Vaughn, Jr.